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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91190878
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Center Cut Hospitality, Inc. Opposer, v. Undisputed International LLC, Applicant.	Opposition No. 91190878
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Brief in Response to Applicant's Motion to Strike

Opposer, Center Cut Hospitality, Inc., ("**Center Cut**") hereby responds to the Motion to Strike (the "**Motion**") filed by Applicant, Undisputed International LLC ("**UIL**") on August 10, 2009.

I. Introduction: UIL's Motion to Strike Should Be Denied.

UIL's Motion to Strike is a bold attempt to circumvent the discovery process and request that the Board rule on certain arguments without allowing Center Cut to submit evidence in support of its arguments. A motion to strike is disfavored, and can only be granted when the movant demonstrates that the opposer's allegations cannot be supported by admissible evidence. UIL has failed to meet this burden. Therefore, the Board should deny UIL's Motion to Strike.

II. Standard of Review: Motions to Strike are Disfavored.

Upon motion, or upon its own initiative, the Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. T.B.M.P. § 506.01; *citing* Fed. R. Civ. Proc. 12(f). Motions to strike are viewed with disfavor and matter will not be stricken unless it clearly has no bearing on the issues involved. *See*

Harsco Corp. v. Electrical Sciences Inc., 9 U.S.P.Q.2d 1570 (T.T.A.B. 1988); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 U.S.P.Q. 401 (T.T.A.B. 1973); *See also*, 2A *Moore's Federal Practice* §12.21[2] (2d ed. 1985); and *Wright & Miller, Federal Practice and Procedure: Civil* 2d §1380 (1990). In deciding whether to strike material from a pleading "it is settled that the motion will be denied, unless it can be shown that no evidence in support of the allegation would be admissible." *Lipsky v. Commonwealth United Corp.*, 552 F.2d 887, 893 (2nd Cir. 1976).

III. UIL's Proposed Mark Is Primarily Merely a Surname.

In its Notice of Opposition, Center Cut alleges that the proposed mark JOHN L. SULLIVAN is primarily merely a surname. Whether the JOHN L. SULLIVAN mark is primarily merely a surname necessarily requires an investigation into the facts. *In re Benthin Mgmt. GMBH*, 37 U.S.P.Q.2d 1332 (T.T.A.B. 1995)("the question of whether a mark sought to be registered is primarily merely a surname within the meaning of the statute can be resolved only on a case by case basis, taking into account a number of various factual consideration.") *quoting Darty et Fils*, 750 F.2d 15, 225 U.S.P.Q 652, 653 (Fed. Cir. 1985). Despite the need for a factual inquiry, UIL moves the court to strike Center Cut's argument on the grounds that the inclusion of the first name "JOHN" and the middle initial "L." are conclusive proof that its proposed mark is not primarily a surname.

The Board has repeatedly rejected UIL's argument. *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204 (CCPA 1953)(holding that S. SEIDENBERG & CO'S. is primarily merely a surname despite the addition of a first initial and term "& CO'S"); *Ex parte Sears Roebuck & Co.*, 96 U.S.P.Q. 360 (D.C. Cir. 1953)(J C HIGGINS held primarily a surname despite addition of first

initial and middle initial to HIGGINS surname); *In re Nelson Souto Major Piquet*, 5 U.S.P.Q.2d 1367 (T.T.A.B. 1987)(N. PIQUET held primarily merely a surname despite addition of first initial “N”); *In re Taverniti*, 225 U.S.P.Q. 1263 (T.T.A.B. 1985)(J. TAVERNITTI held primarily merely a surname despite addition of initial “J”). Indeed, where a mark consists of full name, consumers pay little heed to anything but the surname, i.e., a full name can be (and often is) primarily merely a surname. *John B. Stetson Co. v. Stephen L. Stetson Co.*, 82.F.2d 586, 587 (2nd Cir. 1936)(stating that “little attention is paid to the given name or initials” in finding that “STEPHEN L. STETSON” was confusingly similar to “STETSON”); *E. & J. Gallo Winery*, 967 F.2d 1280 (9th Cir. 1992)(finding that JOSEPH GALLO mark was confusingly similar to GALLO mark). Contrary to UIL’s position, the addition of the first name “JOHN” or the middle initial “L.” to the surname “SULLIVAN” does not change the perception amongst consumers that JOHN L. SULLIVAN is primarily merely a surname.

The determination of whether a particular mark is primarily a surname can only be done on a case by case basis, i.e., there is no rule that the addition of certain material to a surname will render the mark registrable. *Benthin Mgmt. GMBH*, 37 U.S.P.Q.2d 1332 (T.T.A.B. 1995). In *Benthin* the Board indicated that there are at least five different factors that must be evaluated to determine if a particular mark is primarily a surname or not. *Id.* Those factors are: (1) the degree of the surname’s rareness; (2) the connection of the surname to the applicant; (3) whether the mark has any recognized meaning other than that of a surname; (4) whether the mark has the look and sound of a surname; and (5) is mark stylized to the extent that it is distinctive enough so that the mark is not

perceived as primarily a surname. *Id.* Without a factual inquiry into each of these factors, the issue of whether UIL's proposed mark is primarily merely a surname is indeterminable. *Id.*

UIL's argument to strike paragraph 6 is based on a misunderstanding of the law. Any determination that JOHN L. SULLIVAN is or is not primarily a surname requires a factual inquiry and an analysis of the facts that are discovered in that inquiry. In order to prevail on its Motion to Strike, UIL must demonstrate the absence of any facts that *could be admitted* in support of Center Cut's position that the proposed mark JOHN L. SULLIVAN is primarily merely a surname. UIL has failed to so demonstrate, and thus the Board should deny UIL's Motion to Strike paragraph 6 of the Notice of Opposition.

IV. UIL Misrepresents Center Cut's Statements.

In paragraph 4 of the Notice of Opposition, Center Cut argues that its rights in its marks date to at least as early as May 10, 1996. Specifically, Center Cut argues that it has "extensively, continuously and without interruption used [its] Marks beginning at least as early as May 10, 1996 in promoting [its] goods and services." (Notice. Opp. at ¶4). UIL misconstrues this argument as alleging that certain marks were in use on May 10, 1996. Clearly this is not Center Cut's intent. Center Cut identified the date of first use for each of its marks in each mark's respective application. The registrations' dates of first use speak for themselves and are identified and incorporated into Center Cut's Notice of Opposition. To the extent there is ambiguity regarding its argument, Center Cut respectfully requests that the Board grant it leave to amend its Notice of Opposition to clarify its argument on this point.

V. Conclusion: The Board Should Deny UIL's Motion To Strike

In order to prevail on its Motion to Strike, UIL must show that there is no admissible evidence that would demonstrate that the proposed mark JOHN L. SULLIVAN is primarily merely a surname. The Board and other courts have held in similar cases that full names can be primarily merely surnames. The actual determination of whether the JOHN L. SULLIVAN mark is primarily merely a surname cannot be undertaken without a specific factual inquiry. As such, the Board should deny UIL's Motion to Strike paragraph 6 of the Notice of Opposition.

UIL misinterprets Center Cut's argument that it possessed rights in its marks as early as May 10, 1996. UIL's interpretation is overly broad and inconsistent with the registrations themselves. Thus the Board should deny UIL's request to amend paragraph 4, or in the alternative, permit Center Cut to amend its Notice of Opposition.

Respectfully Submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically transmitted via ESTTA to the United States Patent and Trademark Office on this 8th day of September, 2009.


Drew T. Palmer

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Response to Applicant's Motion To Strike has been served on Undisputed International LLC by mailing said copy on September 8, 2009, via First Class Mail, postage prepaid to:

Andrew N. Spivak
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I hereby certify that a true and complete copy of the foregoing Notice of Opposition to has been served on Undisputed International LLC by emailing said copy on September 8, 2009 to the following email address:

aspivak@mosaiclegalgroup.com


Drew T. Palmer